

REMARKS

Claims 11-16 are pending in the above-referenced application.

Claims 11-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,887,269 to Brunts et al. ("Bruns") in view of U.S. Patent No. 5,884,218 to Nimura et al. ("Nimura"). Applicant respectfully submits that the rejection should be withdrawn for the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, but the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness.

Independent claim 11 recites, in relevant parts, a navigation card for use with a key card reader of a radio receiver of a navigation system, which navigation card includes: "a memory in which at least one navigation destination is stored"; "audio data assigned to the at least one navigation destination stored in the memory"; and "wherein the navigation card is insertable into, and read by, the key card reader of the radio receiver, the key card reader normally adapted to read a key card to establish the operational readiness of the radio receiver." Independent claims 13 and 16 recites substantially similar features as the above-recited features of claim 11. As repeatedly explained throughout the prosecution of the present application, the meaning of "audio data assigned to the at least one navigation destination stored in the memory" is clear: it means audio data describing the characteristics of the navigation destination, i.e., "information relating to points of interest . . . , such as museums, historical city districts and other tourist sights" (Substitute Spec., p. 4, l. 27-28), and the "audio file is invoked and played as soon as the [vehicle] has reached a tourist sight that was previously entered as a navigation destination." (Substitute Spec., p. 5, l. 13-15).

With respect to the issue of claim interpretation, Applicant notes that even if one applied the Federal Circuit cases most favorable to the Examiner's position, even if the ordinary and customary meaning of a claim term to persons skilled in the pertinent art is evident, "the inventor's written description of the invention, for example, is relevant and controlling insofar as it provides clear lexicography or disavowal of the ordinary meaning." C. R. Bard Inc. v. United States Surgical Corp., 73 U.S.P.Q.2 d 1011, 1014 (Fed. Cir. 2004). This rule is clearly consistent with the long-standing rules that "Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage," and that the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. MPEP 2111.

In support of the rejection, the Examiner contends that column 7, lines 1-10 of Brunts teaches that "the memory card stores data regarding a navigation destination." Furthermore, while the Examiner acknowledges that the Brunts reference does not disclose or suggest storing audio data assigned to the at least one navigation destination on the memory card, the Examiner contends (without citing any specific section of Nimura) that Nimura teaches "a navigation system including an IC memory card for storing various data such as destination data, voice guidance data, picture showing simple guide route that are necessary for navigation," and therefore "the IC memory card [of Nimura] discussed above inherently associates the destination data and the voice guidance data so that [the] user is able to follow voice data to a selected destination." The Examiner concludes that it would have been obvious to "modify the system of Brunts et al. to include the teachings as taught by Nimura et al. to gain advantage therefore (i.e., a driver can be capable of maintaining safety driving while reaching a selected destination)." Applicant respectfully submits that the actual teachings of Brunts and Nimura do not support the Examiner's obviousness conclusion, for the reasons explained below.

Initially, even if one assumed for the sake of argument that some motivation existed to combine the teachings of Brunts and Nimura (with which assumption Applicant does not agree), the combination still would not teach or suggest the claimed feature of "the navigation card is insertable into, and read by, the key card reader of the radio receiver, the key card reader normally adapted to read a key card to establish the operational readiness of the radio receiver." There is absolutely no teaching or suggestion in either Brunts or Nimura that the navigation card is inserted into a key card reader of the radio receiver that is "adapted to read

a key card to establish the operational readiness of the radio receiver.” For at least this reason, independent claims 11, 13 and 16, as well as their dependent claims 12 and 14-15, are not rendered obvious by Brunts and Nimura.

Independent of the above, with respect to the Examiner’s contention that Brunts teaches that “the memory card stores data regarding a navigation destination,” Applicant notes that column 7, lines 1-10 of Brunts merely discloses that the memory card contains an information directory for a given geographic area. Furthermore, to the extent the Examiner contends (without any specific citation or support) that Nimura teaches “a navigation system including an IC memory card for storing various data such as destination data, voice guidance data, picture showing simple guide route that are necessary for navigation,” and therefore “the IC memory card [of Nimura] . . . inherently associates the destination data and the voice guidance data so that [the] user is able to follow voice data to a selected destination,” Applicant notes that the Examiner’s rationale is not supported at all, either factually or legally.

First, there is absolutely no indication in Nimura that any audio data assigned to a navigation destination is stored anywhere, let alone any indication that audio data assigned to the at least one navigation destination is stored on any memory card, at least not in the sense of the claimed feature of the present invention. Second, even if Nimura suggests storing some type of voice guidance data (or any audio data) on an IC memory card, there is absolutely no logical reason why “the IC memory card . . . inherently associates the destination data and the voice guidance data” as asserted by the Examiner. In order to rely on the doctrine of inherent disclosure, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). “The fact that certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (M.P.E.P. § 2112, citing In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993)). There is simply no reason why alleged destination data would necessarily have to be associated with the alleged voice guidance data of Nimura. Furthermore, even if one assumed for the sake of argument that Nimura suggested associating voice guidance data with a selected destination, Applicant has clearly explained that the claimed feature of “audio data assigned to the at least

one navigation destination stored in the memory” means audio data describing the characteristics of the navigation destination, e.g., “information relating to points of interest . . . , such as museums, historical city districts and other tourist sights,” and there is no suggestion in Nimura that “voice guidance data” (even if one assumes for the sake of argument that it is “inherently associated with destination data” as allegedly disclosed in Nimura) are anything other than driving direction instructions, which is clearly different from audio data describing the characteristics of the navigation destination. In addition, the Examiner has acknowledged that Brunts does not teach or suggest the claimed feature of “audio data assigned to the at least one navigation destination stored in the memory.” For these reasons, a combination of Brunts and Nimura would still fail to teach or suggest the claimed feature “audio data assigned to the at least one navigation destination stored in the memory.”

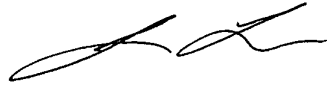
Independent of the above, Applicant notes that claim 11 recites that the navigation card includes “a memory in which at least one navigation destination is stored . . . ; and audio data assigned to the at least one navigation destination stored in the memory,” which means the audio data and the at least one navigation destination are both stored on the same navigation card. Neither Brunts nor Nimura teaches or suggests that the audio data and the at least one navigation destination are both stored on the same navigation card, so a combination of Brunts and Nimura would fail to teach or suggest that the audio data and the at least one navigation destination are both stored on the same navigation card.

For at least these reasons, it is submitted that the combination of Brunts and Nimura (even if one assumes for the sake of argument that some motivation exists for such a combination, with which assumption Applicant does not agree) does not render obvious the subject matter of independent claim 11 and its dependent claim 12. Since independent claims 13 and 16 recite features analogous to those of independent claim 11, it is submitted that claims 13 and 16, as well as their dependent claims 14 and 15, are likewise allowable over the references relied upon.

CONCLUSION

It is respectfully submitted that all pending claims of the present application are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

 (R. No. 36,197)

Dated: 12/2, 2005

By: JONG LEE for Gerard Messina

Gerard A. Messina

Reg. No. 35,952

KENYON & KENYON

One Broadway

New York, NY 10004

(212) 425-7200

CUSTOMER NO. 26646